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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,621	01/11/2002	Matthew S. Luban	10031-007-999	6507
826	7590	10/02/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			RATHINASAMY, PALANI P	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/043,621

**Applicant(s)**

LUBAN ET AL.

**Examiner**

Palani P. Rathinasamy

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/12/2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/11/2002, 4/19/2002</u> .                                    | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. **Claims 1, 4-10, 12-13, 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalina (US5970480).** Kalina teaches of a reward incentive program where members can shop with various merchants and receive rewards that are unique to each merchant. At a central location, member sales transactions are matched with merchant reward contracts to determine reward amounts [abstract].

Regarding claims 1, 12-13, 16-17 Kalina provides a central computer system that maintains in memory: customer accounts [col 3, lines 54-56], rebate instructions [col 3, lines 50-51] and transaction data [col 4, lines 16-19]. Kalina also discusses using an “award card” that will identify the customer with their customer data [col 4, line 16].

When the card is 'swiped' at a merchant site, the transaction data will be sent to a central system using a "communication line" [col 4, lines 16-19]. Kalina describes the communication line as a link between merchants, member banks, creditors and the central computer system [fig 1-1, 1-2]. Upon receiving the transaction data, the central computer will determine the corresponding reward based on the award instructions previously stored [col 4, lines 21-25]. The customer's reward account is then updated to reflect the transaction [col 4, lines 56-67]. Regarding claim 17, credit card payments being transmitted by the merchant are considered electronic payments.

Regarding claims 7 and 8, it is inherent in Kalina that if a successful rebate were made available to a customer, some transmission would occur notifying the merchant to transfer money.

Regarding claim 4, it is inherent in Kalina's patent that upon transaction approval, a message of a successful transaction will be relayed to the merchant [col 4, lines 51-54].

Regarding claim 5, applicant describes that the registration information would be transmitted via network connection. Kalina's description shows that the registration would occur at merchant sites [col 4, lines 5-10] and would be transmitted to the central location. It is inherent that the data would be transmitted along the "communication lines" described above.

Regarding claim 6, applicant claims that the transaction data will be received "via a computer network connection with the financial network." Kalina describes a

“communication line” that would connect the central computer with the merchants, banks and creditors using a computer network [fig 1-1, 1-2].

Regarding claims 9 and 10, applicant describes that the rebates can be used for investments whose allocation is determined by the processor (claim 9) or by an administrator (claim 10). Similarly Kalina describes a method where the awards are used for various types of investments where the central computer determines which investments to purchase based on the merchant or the customer [col 4, line 67 – col 5, lines 1-2]. When the rebate amount exceeds a certain amount (stock price, etc), the security will be purchased for the customer. Applicants claim 10 describes an administrator determining the allocation instructions. It is clear in Kalina that if computer software is able to determine the allocation of investment funds, then a person (such as the programmer who programmed it) is taken to determine the allocation amount.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalina (US5970480) in view of official notice being taken.** Official Notice is being taken that payment-card processing networks will naturally notify merchants, banks, etc. whenever a transaction is declined. For example, if a customer, who has

exceeded his limit on a credit card, tries to make a purchase with the card, the network will turn down the transaction and send proper notification to the merchant. A store merchant will not allow product sales to occur without authorization from the credit card network. It would have then been obvious for Kalina's system to deliver notice of declined authorization.

3. **Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Kalina (US5970480) in view of Ayyoubi et al. (US5233514).** Kalina teaches of a reward system where merchants can offer customers rebates that can be used to purchase investments in various securities. Although a customer is not restricted from using the rebates to buy shares in the companies of the merchants, Kalina does not explicitly teach this. Ayyoubi et al. teaches of a system where a customer can acquire UPC's and redeem them for "stock in the manufacturer or supplier [of] each label" [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to expand Kalina's investment rewards so that they are used to purchase stock in the merchants in addition to general investments.

4. **Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalina (US5970480) in view of Kanter (US5537314).** Kalina teaches of a reward system where merchants can offer customers rebates that can be used to purchase investments in various securities. Kalina does not explicitly teach of the rebates due being a percentage of the total transaction (claim 14). Kanter teaches of an incentive award program where consumers can shop at various merchants and use their rewards in a variety of different methods. Kanter teaches of a specific incentive plan where the

rebate is calculated by multiplying a "discount rate" by a customers purchase amount [col 9, lines 31-39]. Kalina also does not teach of determining the rebate amount based on the individual product being purchased. Kanter teaches that the rebate can be based on the specific merchandise being purchased [col 16, lines 56-60]. It would have been obvious to one of ordinary skill at the time of the invention to use Kalina's reward system to calculate rebates based on a percentage of the total sale (claim 14) or based on the individual product that was purchased (claim 15) or a combination thereof.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "71" in FIG. 3 has been used to designate both ACCOUNT UPDATE and DEPOSIT MONIES. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the

description: 37 (FIG 2) and 430 (FIG 4). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 34 (page 27, line 31), 53 (page 19, line 8). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.



***Specification***

8. The use of the trademarks (MasterCard, etc., page 26 – line 34, page 30 – line 12-13, page 34 – lines 15-16, page 36 – line 22, page 37 – line 24) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.


Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**

PPR